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09/973,426	10/09/2001	Yasuhisa Nakajima	450100-4248.1	6275
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EXAMINER				
WENDMAGEGN, GIRUMSEW				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/973,426

**Applicant(s)**

NAKAJIMA ET AL.

**Examiner**

GIRUMSEW WENDMAGEGN

**Art Unit**

2621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 08/993993.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/13/06; 4/15/02; 10/9/01
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim1,3-4, 9-11,14 and 17-18** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1,1,2,1,1,1,1,1 of U.S. Patent No. 6,556,768 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of present application is obvious variation of 6,556,768. The difference between the present application and patent is that the present application recites plurality of transmitting/receiving means while the patent recites first and second transmitting/receiving means. One ordinary skill in the art would conclude that the invention defined in claim at issue is an obvious variation of the invention defined in a

claim in the patent because first and second transmitting/receiving means is plurality of transmitting/receiving means.

**Claim8, 15 is** rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1, 1 of U.S. Patent No. 6,556,768 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claim of present application is obvious variation of 6,556,768. The only difference between the present application and the patent is that the present application claim recites a power inputting means for inputting power from a power supplying means. However it is old and well known in the art to have a power inputting means in order to the device to be used.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claim1-2, 5-10, 14-18** are rejected under 35 U.S.C. 102(e) as being anticipated by Oguro (Patent No US 6,101,070).

Regarding claim1,9-10, 14,17-18 Oguro anticipates a recording/reproduction apparatus for recording or reproducing data into and from a recording- medium assembly having a storage apparatus mounted thereon for storing predetermined information (see figure 1a and 1b,column7 line 26-32), said recording/reproduction apparatus comprising: a plurality of information transmitting/receiving means for transmitting and receiving said information to and from said storage apparatus ( see column3 line6-17, column26 line56-column27 line 1-61, figure1b); a switching means for switching said information transmitting/receiving means from one to another (see column3 line6-17, column26 line56-column27 line 1-61, figure1b 18a and 18b); a reading means for reading out said information stored in said storage apparatus through one of said information transmitting/receiving means selected by said switching means ( see column3 line6-17, column26 line56-column27 line 1-61); and an information supplying means for supplying update information for updating said information stored in said storage apparatus through one of said information transmitting/receiving means selected by said switching means ( see column3 line6-17, column26 line56-column27 line 1-61).

Regarding claim2, Oguro anticipates a recording/reproduction apparatus according to claim 1 wherein said information is information on data recorded in said recording-medium assembly (see column20 line23-34).

Regarding claim5, Oguro anticipates a recording/reproduction apparatus according to claim 1 further having a power supplying means for supplying power to said storage apparatus (see figure53a element 60 and 53b element 71).

Regarding claim6, Oguro anticipates a recording/reproduction apparatus according to claim 1 wherein said information is preset information (see column30 line 4-7).

Regarding claim7, Oguro anticipates a recording/reproduction apparatus according to claim 1 wherein said information includes identification data for identifying said data recorded in said recording assembly (see column20 line23-30).

Regarding claim8,15, Oguro anticipates a recording/reproduction apparatus according to claim 5 wherein said storage apparatus comprises: a storage means for storing said information(see column22 line 35-37); a power inputting means for inputting power from a power supplying means (see figure53A element 60 and 53b element 71); an information providing means for providing said information stored in said storage means to said reading means through one of said information transmitting/receiving means (see column23 line 6-17, column26 line56-column27 line 1-61); and an information updating means for updating said information stored in said storage means with said update information supplied by said information supplying means through one

of said information transmitting/receiving means (see column26 line56-column27 line 1-61).

Regarding claim11, Oguro anticipates an input/output apparatus according to claim10 comprising an information updating means for updating said information received through said information transmitting/receiving means and stored in said storage apparatus ( see column26 line56-column27 line 1-61).

Regarding claim16, Oguro anticipates a storage apparatus according to claim 15 wherein: said storage apparatus is attached to a recording medium assembly for recording data (see figure 53b); said storage apparatus is used for storing information to be added to said data recorded in said recording-medium assembly and/or to be used for updating said data (see column26 line56-column27 line 1-61).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim19-20, 22** rejected under 35 U.S.C. 103(a) as being unpatentable over Bang et al (Patent No US 5,965,456) in view of Nagano et al (6,240,240).

Regarding claim19, Bang et al (hereinafter Bang) teaches an information transmitting apparatus for transmitting data and predetermined information to a recording/reproduction apparatus for recording or reproducing said data into and from a recording-medium assembly, on which a storage apparatus for storing said predetermined information is mounted (see figure1 column1 line 22-38) but does not teach superposing said information on said data. However Nagano et al (hereinafter Nagano) teaches superposing information (program guide) in the vertical blanking interval (see column7 line 32-41).

One of ordinary skill in the art at the time the invention was made would have been motivated to insert information in vertical blanking interval as in Nagano in to Bang because it would use limited bandwidth to transmit the information.



Regarding claim20, Bang teaches an information transmitting apparatus according to claim 19 wherein said information is information on said data (see column1 line45-53).

Regarding claim22, Nagano teaches an information transmitting apparatus according to claim 19 wherein said information superposing means inserts said information into an interval of a vertical-synchronization signal of a broadcasted signal conveying said data (see column7 line32-41).

**Claim12-13, 19,21-22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Oguro (Patent No US 6,101,070) as applied to Claim 27 of this application is rejected for the same reasons as discussed in claim 25 of this application.-2, 5-10, and 14-18, further in view of Nagano et al (6,240,240).

Regarding claim12, see the teaching of Oguro above. Oguro does not teach transmitting said information to said storage apparatus intermittently at a predetermined period. However Nagano teaches information (program guide) can be intermittently inserted at a predetermined period (see column7 line 32-60).

One of ordinary skill in the art at the time the invention was made would have been motivated to insert information at a predetermined period in vertical blanking interval as in Nagano in to Oguro because it would allow the use of single channel to transmit two different data.

Regarding claim13, Oguro teaches an input/output apparatus according to claim 12 wherein said information transmitting/receiving means shortens said period at which said information is transmitted to said storage apparatus when information is received from said storage apparatus (see column23 line6-17).

Regarding claim19, see the teaching of Oguro. Oguro does not teach superposing said information on said data. However Nagano et al teaches superposing information (program guide) in the vertical blanking interval (see column7 line 32-41).

One of ordinary skill in the art at the time the invention was made would have been motivated to insert information in vertical blanking interval as in Nagano in to Oguro because it would use limited bandwidth to transmit the information.

Regarding claim21, Oguro teaches an information transmitting apparatus according to claim 19 wherein said storage apparatus comprises: a storage means for storing said information(see column22 line 35-37); a power inputting means for inputting power supplied by a predetermined external apparatus(see figure53A element 60 and 53b element 71); an information supplying means for providing said information stored in said storage means to said external apparatus see column23 line 6-17, column26 line56-column27 line 1-61); and an information updating means for updating said information stored in said storage means with said information received from said external apparatus (see column26 line56-column27 line 1-61).

Regarding claim22, Nagano teaches an information transmitting apparatus according to claim 19 wherein said information superposing means inserts said information into an interval of a vertical-synchronization signal of a broadcasted signal conveying said data (see column7 line32-41).

Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, absent unexpected results to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIRUMSEW WENDMAGEGN whose telephone number is (571)270-1118. The examiner can normally be reached on 7:30-5:00, M-F, alr Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Girumsew Wendmagegn/  
Examiner, Art Unit 2621

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621